



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,772	01/18/2000	Jeffrey W. Small	30566.86US01	1090

22462 7590 06/08/2004

GATES & COOPER LLP
HOWARD HUGHES CENTER
6701 CENTER DRIVE WEST, SUITE 1050
LOS ANGELES, CA 90045

EXAMINER

SHAH, SANJIV

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 06/08/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/484,772

Applicant(s)

SMALL, JEFFREY W.

Examiner

Sanjiv D. Shah

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 5-10, 12, 14-20, 22, 24-30, 32 and 34 are rejected under 35

U.S.C. 102(e) as being anticipated by Snyders (Patent # 5,982,996).

Regarding claim 5, 15, 25, Snyders teaches the claimed invention of associating multiple output device as shown in fig 1.

A computer with information is shown in fig 1, element 10

One or more printer (output device) configuration stored is shown in fig 9, element S7.24.

Selecting information is shown in fig 7, element s3 and s3

Selecting one or more output device configuration is shown in fig 7, element s7

Associating information with output device configuration is shown in fig 10, element S7.26.

Regarding claims 6, 7, 8, 16, 17, 18, 26, 27, 28, Snyders shows a information to be printed as a graphics or drawing file as shown in fig 7, element S3.

Art Unit: 2176

Regarding claims 9, 19, 29, Snyders teaches the claimed invention of obtaining setting of the printer and associating it with the information as shown in fig 9, element S7.22, S7.23 and S7.26.

Regarding claims 10, 14, 20, 24, 30, 34, Snyders teaches the claimed information of saving the setting as shown in fig 9, element S7.24

Regarding claims 12, 22, 32, Snyder teaches a printer as shown in fig 1, element 14, 16 and 18.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2176

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 11, 13, 21, 23, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyders (Patent 5,982,996) in view of Marbry et al. (Patent # 5,692,111).

Regarding claim 11, 21, 31, Snyders teaches the claimed invention as described above with respect to claim 1. Snyders does teach multiple printers to select from as shown in fig 1 but does not specifically teach listing the printer configuration and presenting list of printers as claimed. Marbry et al. does. Specifically, Marbry et al. teaches the claimed invention of listing available printers as described in col. 3, lines 20-22, Presenting the configuration information is described in col. 3, lines 30-35 and selecting one printer for printing is described in col. 3, lines 63-65.

Therefore it would have been obvious for a person with ordinary skill in the art at the time the invention was made to include printer selection teachings of Marbry et al. in the method of Snyders because it provides easy access by organizing all available printer under one menu.

Regarding claims 13, 23, 33, Marbry et al. teaches selecting a printer whose configuration is not locally installed as described in col. 3, lines 25-30. This limitation is equivalent to claimed "none" selection as Marbry does teach obtaining the configuration and providing the access that is equivalent to selecting similar configuration.

Response to Arguments

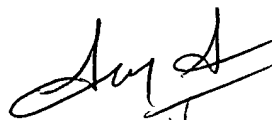
6. Applicant's election with traverse of Group II in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the two inventions are not distinct and independent because they present similar inventive concept. This is not found persuasive because Group I claims a subject matter to associate different layout of drawings to different output device, that is to associate different portion of file to different output device, whereas Group II claims a subject matter to configure an output device. Both groups has separate utility and to configure an output device it is not required to associate different layout of drawings with different output device as claimed in Group I. Therefore the two Groups are in fact distinct and independent and there is an additional burden on Examiner to search different inventions. Therefore the requirement is still deemed proper and is made FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjiv D. Shah whose telephone number is (703) 305-8355. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanjiv D. Shah
Primary Examiner
Art Unit 2176

S. Shah
May 29, 2004